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Case No.: 59522US003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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First Named Inventor:	BRUNNER, DENNIS M.		
Application No.:	10/791966	Group Art Unit:	2811
Filed:	March 3, 2004	Examiner:	Nitin Parekh
Title:	PARTIALLY ETCHED DIELECTRIC FILM WITH CONDUCTIVE FEATURES		

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]
I hereby certify that this correspondence is being:
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☑ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

5-12-05 Melanie Gover
Date Signed by: Melanie G. Gover

Dear Sir:

This is in response to the Office Action mailed April 22, 2005. Claims 1-27 are pending. Claims 1-27 were restricted under 35 USC § 121 as follows:

I. Claims 24-27 are said to be drawn to a semiconductor substrate/device, classified in Class 257, subclass 774;

II. Claims 1-23 are said to be drawn to a method of making a semiconductor device, classified in Class 438, subclass 629;

Election

In response, Applicants elect Group II, with traverse.

Reconsideration and withdrawal or modification of the restriction requirement is respectfully requested.

In Group II, Applicants broadly claim a method of making a semiconductor device.

The Restriction Requirement in Paragraph 2 states:

The inventions are distinct, each from the other because of the following reasons:
Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). In the instant case unpatentability of Group I invention would not necessarily imply unpatentability of the process of the group II invention, since the device of group I invention could be made by the processes different from those of group II invention. For example, providing the metallic projection by selectively sputtering the dielectric film instead of etching.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicants submit that the Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I and II claims in different classes and subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group II were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Conclusion

Applicants have elected Group II. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the

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fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

May 12, 2005
Date

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